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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/260,586	06/16/94	LORENCE R	57704

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SCHEINER, L. EXAMINER	
ART UNIT	PAPER NUMBER
1813	11

DATE MAILED:
08/14/95

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

The holding of abandonment mailed 8/3/95, has been withdrawn

The above-mentioned application has been returned to pending status.

Jackie Waldo, Supervisory
Legal Instrument Examiner
Group Art Unit 1800

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 13-36 are pending in this application.

Claims 13-18, and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-17 of copending application Serial No. 08/055,519. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method claims broadly drawn to "sarcoma" and "carcinoma" would encompass the more narrowly defined methods of application Serial No. 08/055,519.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Applicants fail in particularly pointing out a specific basis for the newly recited "mesogenic strain". Moreover, the recitation of "retinoic acid" also appears to be new matter.

Claims 23, 26, and 35 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-18, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bohle et al for reasons of record.

Claims 13-18, and 20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Cassel et al for reasons of record.

Claims 13-18, and 20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Murray et al for reasons of record.

Applicants' remarks regarding Cassel et al, Murray et al, and Bohle et al are acknowledged. However, arguments are not persuasive. The Lorence declaration is also acknowledged. The Katz declaration is sufficient to remove the Reichard et al reference.

Applicants' arguments with regard to Cassel et al, Murray et al, and Bohle et al are not convincing since they are not commensurate in scope with the claims. That is, while the respective references apparently teach the administration of less virus than that disclosed in the instant examples, the claims are not so limited. That is, the claims merely require an amount of NDV effective to treat cancer, and no mechanism is required. Thus, the claims do not preclude using an amount effective to treat cancer by stimulating the immune response. Moreover, the claims do not even require systemic administration.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P.

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner whose telephone number is (703) 308-1122.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is (703) 305-7939.

LAS

Laurie Scheiner/LAS

MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800